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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,136	11/12/2003	Gary Ames Peck	397.091300	6221

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THE BILICKI LAW FIRM, P.C.
1285 North Main Street
Jamestown, NY 14701

EXAMINER

CASTELLANO, STEPHEN J

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3781

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/706,136	Applicant(s) PECK, GARY AMES	
	Examiner /Stephen J. Castellano/	Art Unit 3781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3781

The amendment filed April 21, 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant has deleted paragraphs 1-39 of the written description. The Technical Field, Background of the Invention and the Summary of the Invention sections have been deleted in the entirety. This portion of the specification represents about half of the written description and most certainly deletes information originally presented in the specification when this application was filed on November 12, 2003.

Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 40-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 40 discusses that the topple resistant receptacle has a flat bottom surface. The flat bottom surface could be either the top or upwardly facing surface or the bottom or downwardly facing surface but not both. Claim 40 states that the flat bottom surface has both a top side and a bottom side. Claim 40 is indefinite. For similar reasoning, claims 41 and 42 are indefinite as well.

Claim 40 states in the preamble that a tool tray (singular) is the subject of the claim. In lines 8 and 9, the top margin of one tray (first tray) fits within the groove of a second tray placed on top of the first tray. This statement in lines 8 and 9 positively recites the

Art Unit: 3781

stacking of two trays. It can't be determined if applicant is claiming one tray or two trays in a stacked configuration.

Claim 40 recites the limitation "the first tray" in line 9. There is insufficient antecedent basis for this limitation in the claim.

The preambles of claims 52-54, 56 and 59 do not match the independent claim and at least one other intervening claim. For example, claim 52 is directed to "the kit" when it depends from claims 49 and independent claim 40. Both claims 49 and 40 are directed to a tray. There is no antecedent basis for "the kit" in claim 52. Claims 52-54, 56 and 59 are indefinite.

Claims 52-54, 56, 59, 61 and 63-64 are not understood because they have antecedent basis errors. In most instances, the claims have been written as though they depend from the claim that immediately precedes itself. However, none of these claims is dependent upon the claim that immediately precedes itself. For example, claim 52 lacks antecedent basis for "said brush bristle wiping member" set forth in lines 1 and 2 because claim 52 depends from claim 49 and 40. The "brush bristle wiping member" is discussed in claim 51 which immediately precedes claim 52. Claims 52-54, 56, 59, 61 and 63-64 are poorly written, confusing and indefinite.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3781

Claims 40-41, 43-46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (4852759) (Williams) in view of O'Neil et al. (4815604) (O'Neil) and Morrison (2003/0230244).

Williams discloses a stackable painter's tool tray and topple resistant receptacle comprising a flat bottom with top surface and bottom surface, a paint can securing member (10a), a spill retainer wall (walls 12-15). Williams discloses the invention except for the double wall of the spill retainer wall and the guide members. O'Neil teaches both the double wall and the guide members: (1) the outer spill retainer wall has a double wall construction at the corner legs 28, 29 wherein a groove is formed between inner and outer walls, a top margin of a below nested tray will fit into the groove of an above nested tray as shown in Fig. 3 and (2) guide members 33, 34 project from the top of the spill retainer wall and provide a defined area for receiving a handle of a paint brush or paint roller. It would have been obvious to add the double wall construction to add stability and to add the guide members to retain a handle of a paint tool.

If it should be deemed that the corner leg outer walls are insufficient. Morrison teaches a pet bowl with an outer wall around the entire circumference. It would have been obvious to add the double wall construction to add stability and prevent the tray from toppling.

Re claim 46, both the raised shoulder and the rib of Williams are resilient.

Re claim 48, Williams discloses the invention except for the size. It would have been obvious to modify the size of the topple resistant receptacle to be at least equal to two times the surface area of the bottom of a gallon container as a matter of design choice in selecting a size large enough to retain a significant amount of the volume of a full gallon paint can if such should spill.

Art Unit: 3781

Claims 42, 51, 55, 57 and 60-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of O'Neil, Morrison and Crump (3894650).

The application of Williams, O'Neil and Morrison are as previously stated. These references disclose the topple resistant receptacle of the tool kit and fail to disclose the slot shield. Crump teaches the slot shield comprising a disk with top side, bottom side, center opening, exterior perimeter and a brush securing member 50 having a resilient gripping member 54 arranged to secure a paint brush against a backing surface 52. It would have been obvious to (1) add a slot shield to eliminate paint loss into a paint container groove and (2) add a brush securing member in order to support a brush over the paint to allow excess paint to drip into the paint can to conserve paint.

Re claim 51, the edges of 52 of Crump provide a brush wiping member.

Re claim 57, Crump teaches a gripping tab 60.

Re claims 60-64, Williams discloses the invention except for the adapter plate and the ladder hook. The Official notice taken in the Office action mailed June 8, 2006 that adapter plates and ladder hooks are well known has not been challenged. The Official notice was treated as a prior art admission in the final Office action mailed May 10, 2007. It would have been obvious to add the adapter plate to provide a means to convert the circular attachment to a rectangular attachment. It would have been obvious to add the ladder hook to suspend the receptacle from a ladder.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of O'Neil and Morrison as applied to claim 40 above, and further in view of Demitry (6971420).

Art Unit: 3781

The combination discloses the invention except for the shape. Demitry teaches a spill tray with an oblong shape, rectilinear at one end and curved at the opposite end. It would have been obvious to modify the spill tray of Williams to have this shape to provide a shape that corresponds to the items being supported, a rectilinear shape for a paint brush and a curved shape for a cylindrical paint container.

Claims 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of O'Neil and Morrison as applied to claim 40 above, and further in view of DiNardo (3407429).

The combination discloses the invention except for the paint can securing member being a plurality of securing members. DiNardo teaches a plurality of securing members 32 (four securing members) which secure at intermittent points. It would have been obvious to modify the securing member to be any number of securing members of DiNardo as the change from Williams' circumferential, continuous securing to an intermittent point securing saves weight and material.

Re claim 50, the securing members are capable of securing differently sized paint cans having the same bottom circumferential diameter but differ in volume and height. The intermittent point securing is capable of securing containers of different shape, such as square.

Claims 52, 53 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of O'Neil, Morrison and DiNardo as applied to claims 49 and 50 above, and further in view of Crump.

The combination discloses the topple resistant receptacle of the tool kit and fail to disclose the slot shield. Crump teaches the slot shield comprising a disk with top side, bottom

Art Unit: 3781

side, center opening, exterior perimeter and a brush securing member 50 having a resilient gripping member 54 arranged to secure a paint brush against a backing surface 52. It would have been obvious to (1) add a slot shield to eliminate paint loss into a paint container groove and (2) add a brush securing member in order to support a brush over the paint to allow excess paint to drip into the paint can to conserve paint.

Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of O'Neil, Morrison and DiNardo as applied to claim 49 above, and further in view of Cogdill (6213338).

The combination discloses the topple resistant receptacle of the tool kit and fail to disclose the slot shield. Cogdill teaches the slot shield comprising a disk with top side, bottom side, center opening, exterior perimeter and a brush wiping bar 30. It would have been obvious to (1) add a slot shield to eliminate paint loss into a paint container groove and (2) add a brush wiping bar in order to remove excess paint from a brush over the paint to allow excess paint to drip into the paint can to conserve paint.

Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of O'Neil, Morrison and Crump as applied to claim 42 above, and further in view of Cogdill.

The combination discloses the invention except for the wiping shield. Cogdill teaches a brush wiping shield 30. It would have been obvious to add a brush wiping shield in order to remove excess paint from a brush over the paint to allow excess paint to drip into the paint can to conserve paint.

Art Unit: 3781

Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of O'Neil, Morrison, DiNardo and Crump as applied to claim 56 above, and further in view of Cogdill.

The combination discloses the invention except for the wiping shield. Cogdill teaches a brush wiping shield 30. It would have been obvious to add a brush wiping shield in order to remove excess paint from a brush over the paint to allow excess paint to drip into the paint can to conserve paint.

Applicant's arguments with respect to claims 40-64 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3781

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Stephen J. Castellano/ whose telephone number is 571-272-4535. The examiner can normally be reached on increased flexibility plan (IFP).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony D. Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen J. Castellano/
Primary Examiner
Art Unit 3781

sjc